

REMARKS

1. In response to the final Office Action mailed August 30, 2006, Applicants respectfully request reconsideration. Claims 1-8 and 10-75 were last presented for examination. Claims 18-75 were previously withdrawn. Claims 1-8 and 10-17 were rejected in the outstanding Office Action. By the foregoing Amendments, claims 1-8 and 10-17 have been amended. No claims have been cancelled or added. Claims 18-75 remain withdrawn. Thus, upon entry of this paper, claims 1-8 and 10-75 will be pending in this application. Of these seventy-four (74) claims, seven (7) claims are independent. Based on the above Amendments and following Remarks, Applicants respectfully request that the outstanding objections and rejections be reconsidered, and that they be withdrawn.

Art of Record

2. Applicants acknowledge receipt of the form PTO/SB/08A filed by Applicants on June 15, 2006, which has been initialed by the Examiner indicating consideration of the references cited therein.

Election

3. In the outstanding Office Action, the Examiner maintained the restriction requirement. Although Applicants respectfully disagree with the Examiner, in order to expedite prosecution of the application, Applicants has elected species I. Accordingly claims 18-75 have been withdrawn.

Claim Rejections

4. Independent claim1 and dependent claims 2-8 and 10-17 have been rejected under 35 U.S.C §103(a) as being unpatentable over U.S. Patent No. 6,617,872 to Vogley (hereinafter, referred to as "Vogley") in view of U.S. Publication NO 2003/0120969 to Hawkins (hereinafter "Hawkins.") Based on the above Amendments and following Remarks, Applicants respectfully request that the outstanding objections and rejections be

reconsidered, and that they be withdrawn.

5. Claim 1, as amended, recites, in part “[a]n electronic system comprising:

a host controller configured to execute an operating system and one or more management agents;
a plurality of components configured to provide functionality for the electronic system; and
a margin testing system for margin testing one or more of the components of the electronic system...

6. In rejecting claim 1, the Examiner relied on Vogley as allegedly disclosing a controller and digital parameter as recited by original claim 1. For the below discussed reasons, Applicants respectfully submit that Vogley fails to teach an electronic system comprising a margin testing system as recited by amended independent claim 1.

7. Vogley is directed to an integrated circuit test arrangement for testing integrated circuit devices at a variety of high clock rates. (*See*, Vogley at Abstract.) In the system of Vogley, individual integrated circuits (24 and 25) are plugged into test sockets (30 and 31) to be tested. (*See*, Vogley at col. 2 lns. 57-60.) The integrated circuit is then tested thus allegedly permitting a integrated circuit manufacturer to test large numbers of integrated circuits. (*See*, Vogley at col. 3 lns. 1-6.) As such, Vogley is directed to a specialized piece of equipment for testing integrated circuits, e.g., for quality control purposes, prior to shipment or sale of the integrated circuits. (*See e.g.*, Vogley at col. 1 lns 18-28.) Thus, in the system of Vogley, integrated circuits 24, 25 are temporarily inserted into test sockets 30, 31 of the testing device 20 where they are tested, and if they pass they may be shipped for inclusion in an electronic device. These integrated circuits 30 and 31 therefore do not provide functionality to the test device 20 of Vogley, but instead are merely inserted into the test device 20 for testing purposes. As such, Applicants respectfully submit that Vogley fails to teach or suggest incorporating a margin testing system in an electronic device (e.g., a computer server).

8. Applicants therefore respectfully submit that Vogley fails to teach or suggest “an electronic device comprising: a host controller ..., a plurality of components configured to provide functionality for the electronic system; and a margin testing system for margin

testing one or more of the components of the electronic system...,” as recited by claim 1.

9. Applicants also respectfully submit that Hawkins, the secondary reference relied on by the Examiner in rejecting the claims, does not cure this defect. In the Office Action, the Examiner merely relied on Hawkins merely for allegedly disclosing a BMC that monitors a response of an electronic system. Hawkins, however, like Vogley fails to teach or suggest an electronic system comprising a margin testing system, as recited by claim 1.

10. Applicants accordingly respectfully submit that claim 1 is in condition for allowance for at least the reason that the cited references, whether taken alone or in combination, teach or suggest “[a]n electronic device comprising: a host controller ..., a plurality of components configured to provide functionality for the electronic system; and a margin testing system for margin testing one or more of the components of the electronic system...,” as recited by claim 1

***Motivation to Combine The Examiner has Failed to Provide
Evidence of a Motivation to Combine***

11. The §103 rejections are *prima facie* improper because they provide no appropriate basis for combining Vogley and Hawkins. As set forth in the Manual of Patent Examining Procedure (MPEP) at § 706.02(j), “To establish a *prima facie* case of obviousness . . . ***there must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or ***to combine reference teachings*** (emphasis added)” *In re Vaeck*, 947 F.2d. 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” Further, as held by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), ***specific reasons must be shown in the art suggesting a combination of references in the manner claimed***. (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”); *Also see, In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill that suggests the claimed combination.”)).

12. In response to Applicant's prior argument that the Examiner failed to provide any evidence of any motivation to combine, the Examiner modified the obviousness rejection to cite to a portion of Hawkins for allegedly providing this missing motivation. Particularly, the Examiner stated that it would have been obvious to one of skill in the art to modify Vogley to include the teachings of Hawkins because "adding a baseboard management controller would have allowed the skilled artisan to provide intelligence to the platform management." (*See*, Office Action at 4.) In support the Examiner pointed to paragraph 15 of Hawkins. (*See*, Office Action at 4.)

13. This alleged motivation, however, is deficient for at least the reason that it fails to provide a motivation to combine the references in the manner recited by Applicant's claim 1. Rather, this section merely provides a reason to use BMCs in general. It, however, fails to explain why one of skill in the art might be motivated to use a BMC in the testing device of Vogley to monitor a response of the components under test.

14. As such, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for at least the reason that the Examiner has failed to establish a motivation in the references evidencing a motivation to combine the references in the manner claimed. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection under §103 for at least this reason.

Dependent Claims

15. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter which makes them *a fortiori* independently patentable over the art of record. Accordingly, Applicants respectfully request that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

Conclusion

16. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael G. Verga', written over a horizontal line.

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